

03-09-00

CPA  
GP 3732Practitioner's Docket No. CHAN-23

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re prior application of: Kwan-Ho Chan

Application No.: 09/315,918

Group No.: 3732

Filed: 05/20/99

Examiner: E. Robert

For: APPARATUS AND METHOD FOR LIGAMENT FIXATION

NOTE: "In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability: (i) Title of invention; (ii) Name of applicant(s); and (iii) Correspondence address." 37 C.F.R. § 1.53(d)(8).

Box CPA

Assistant Commissioner for Patents

Washington, D.C. 20231

 RECEIVED  
 MAR 10 2000  
 T.C. S.

## CONTINUED PROSECUTION APPLICATION (CPA)

(37 C.F.R. § 1.53(d))

NOTE: A continued prosecution application can only be used to file a divisional or continuation of a prior nonprovisional application and can NOT be used to file a continuation-in-part application. 37 C.F.R. § 1.53(d)(1).

**WARNING:** While facsimile transmission can be used to obtain a date of transmission for this correspondence the date on the certificate of transmission (§ 1.8(a)) of an application under § 1.53(d) (CPA) is not controlling (or even relevant), in that a CPA filed by facsimile transmission will not be accorded a filing date as of the date on the certificate of transmission (§ 1.8(a)) unless Office records indicate, or applicant otherwise establishes pursuant to § 1.6(f), receipt in the Office of the complete application under § 1.53(d) on the date on the certificate of transmission, and that date is not a Saturday, Sunday, or Federal holiday. 37 C.F.R. § 1.8(b)(3) and 62 FR 53131, 53133, October 10, 1997. Requests for a continued prosecution application filed by facsimile transmission should be clearly marked "Box CPA". 37 C.F.R. § 1.53(d)(9).

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10**  
 (When using Express Mail, the Express Mail label number is mandatory;  
 Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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Signature

Mark J. Pandiscio

(type or print name of person certifying)

Date: March 8, 2000

03/10/2000 STEFFERRA 00000055 09315918

 01 FC:231  
 02 FC:203

 345.00 OP  
 72.00 OP

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Before using the CPA procedure note that a CPA application (§ 1.53(d)) cannot be amended to delete the specific reference to a prior application (e.g., for patent term purposes), as well as the specific reference to any application to which the prior application contains a specific reference under 35 USC 120, 121 and 365(c) and the expiration date under 35 USC 154(b)(2) of any patent issuing from the § 1.53(d) application will be based upon the filing date of the prior application (or the earliest application to which the prior application contains a reference under 35 USC 120, 121, and 365(c)). 62 FR 53131, 53145, October 10, 1997.

**WARNING:** A continued prosecution application "is a request to expressly abandon the prior application" as of its filing date. 37 C.F.R. § 1.53(d)(2)(v).

**WARNING:** While the filing of a continued prosecution application is the specific reference required by 35 U.S.C. § 120 to every application assigned the application number, identified in such request, no amendment in the application may delete the specific reference to any prior application (e.g., for patent term purposes). 37 C.F.R. § 1.53(d)(7).

**WARNING:** A request for an application under § 1.53(d) (CPA) cannot be submitted within papers filed for another purpose (e.g., the filing of a "conditional" request for a continued prosecution application within an amendment after final for the prior application). A "conditional" request for a CPA submitted (as a separate paper) with an amendment after final will be treated as an unconditional request for a CPA. This will result (§ 1.53(d)(2)(v)) in the abandonment of such prior application, and (if so instructed in the request for CPA) the amendment after final in the prior application will be treated as a preliminary amendment in the CPA. 62 FR 53131, 53140, October 10, 1997.

**NOTE:** "The filing date of a continued prosecution application is the date on which a request on a separate paper for an application . . . is filed." 37 C.F.R. § 1.53(d)(2)(emphasis added).

1. This is a request for the filing of a

- ☒ continuation  
☐ divisional

continued prosecution application under 37 C.F.R. § 1.53(d) of the above-identified prior nonprovisional application, which prior nonprovisional patent application claimed\*\*\*

It is further requested that this continued prosecution application utilize the file jacket and contents of the prior application, including the specification, drawings, and oath or declaration from the prior application, to constitute this new application, and that the application number of the above-identified prior application be assigned for identification purposes. 37 C.F.R. § 1.53(d)(2)(iv).

It is also requested that the above-identified prior application be expressly abandoned as of the filing date accorded this continued prosecution application. 37 C.F.R. § 1.53(d)(2)(v).

2. With respect to the above-identified prior nonprovisional application, this continued prosecution application is being filed:

A. ☒ before the earliest of the:

- ☐ termination of the proceedings on the prior application (37 C.F.R. § 1.53(d)(1)(ii)(C))  
☐ payment of the issue fee on the prior application (37 C.F.R. § 1.53(d)(1)(ii)(A)).  
☒ abandonment of the prior application (37 C.F.R. § 1.53(d)(1)(ii)(B))

OR

B. ☐ after the payment of the issue fee — but a petition under § 1.313(b)(5) has been granted in the prior application. 37 C.F.R. § 1.53(d)(1)(ii)(A).

C. The term for response or taking action in the prior application expires on 3/8/00.

☒ An extension of time in the prior application is:

- ☒ filed concurrently in the prior application  
☐ has been filed on \_\_\_\_\_

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\*\*\*benefit or pending prior U.S. Provisional Patent Application Serial No. 60/086,329, filed 5/21/98 by Kwan-Ho Chan for APPARATUS AND METHOD FOR LIGAMENT FIXATION and U.S. Provisional Patent Application Serial No. 60/125,745, filed 3/23/99 by Kwan-Ho Chan for APPARATUS AND METHOD FOR LIGAMENT FIXATION.

## 3. It is noted that:

- This application discloses and claims only subject matter disclosed in the prior application. 37 C.F.R. § 1.53(d)(2)(ii).
- Filing of this continued prosecution application is to be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. § 122, to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning, either the prior application or any continuing application filed under the provisions of 37 C.F.R. § 1.53(d), may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket. 37 C.F.R. § 1.53(d)(6).
- Filing of this request is the specific reference required by 35 U.S.C. § 120 to every application assigned the application number identified in this request. No amendment in this application may delete this specific reference to any prior application. 37 C.F.R. §§ 1.53(d)(7) and 1.78(a)(2).

## 4. This continued prosecution application names as inventors:

- ☒ the same inventors named in the prior application on the date this continued prosecution application under 37 C.F.R. § 1.53(d)(2)(iii) is being filed.
- ☐ fewer than all the inventors named in the prior application. 37 C.F.R. § 1.53(d)(4).

NOTE: A CPA application may be filed by fewer than all the inventors named in the prior application, provide the request for an application under 37 C.F.R. § 1.53(d), when filed, is accompanied by a statement requesting deletion of the name(s) of the person(s) who are not the inventors of the invention being claimed in the new application. 37 C.F.R. § 1.53(d)(4).

- ☐ Please delete the following name(s) as inventor(s), who are not inventor(s) of the invention being claimed in this new application:

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NOTE: "No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of a petition under § 1.48." 37 C.F.R. § 1.53(d)(4).

NOTE: A request for an application under § 1.53(d) purporting to name as an inventor a person not named as an inventor in the prior application (even if accompanied by a new declaration/oath under § 1.63 listing that person as an inventor) will be treated as naming the same inventors named in the prior application (§ 1.53(d)(2)(iii)). 62 FR 53131, 53141, October 10, 1997.

- ☐ Please add the following name(s) as inventors:

---

- ☐ A petition under § 1.48 is attached.

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5. Attached hereto is an amendment to the prior application as it existed prior to the filing of this continuation prosecution application. \*\*\*

**NOTE:** "Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125." 37 C.F.R. § 1.53(d)(5).

**WARNING:** An amendment after final filed and refused entry in the prior application will not be automatically entered in the CPA and specific instructions to enter amendment(s) refused entry in the prior application must be filed. Q&A 64, "Changes in Patent Practice and Procedure," effective December 1, 1997, supplemented up to February 1, 1998.

#### 6. Fee Calculation

**NOTE:** "(3) The filing fee for a continued prosecution application filed under this paragraph is:

(i) The basic filing fee as set forth in § 1.16; and

(ii) Any additional \$ 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under § 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application."

37 C.F.R. § 1.53(d)(3)(i) and (ii).

A. ☒ Regular application

#### CLAIMS AS FILED

Number filed	Number Extra	Rate	Basic Fee 37 C.F.R. § 1.16(a)
			\$690.00 144.00
Total Claims (37 C.F.R. § 1.16(c))	28-20= 8 X	\$18.00=	
Independent Claims (37 C.F.R. § 1.16(b))	2 -3= 0 X	\$78.00=	0.00
Multiple dependent claim(s), if any (37 C.F.R. § 1.16(d))	+	\$260.00	0.00

- ☐ An amendment canceling extra claims is enclosed.  
☐ An amendment deleting multiple-dependencies is enclosed.  
☐ The fee for extra claims is not being paid at this time.

**NOTE:** If the fees for extra claims are not paid on filing, they must be paid or the claims canceled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 C.F.R. § 1.16(d).

Filing Fee Calculation

\$ 834.00

\*\*\*No amendment is being attached to this Continued Prosecution Application at the time of filing.

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B. ☐ Design application

(\$310.00—37 C.F.R. § 1.16(f))

Filing Fee Calculation

\$ \_\_\_\_\_

C. ☐ Plant application

(\$480.00—37 C.F.R. § 1.16(g))

Filing Fee Calculation

\$ \_\_\_\_\_

## 7. Small Entity Statement(s)

**WARNING:** Small entity status must not be established unless the person(s) signing the statement can unequivocally make the required self-certification. M.P.E.P., § 509.03, 6th ed., rev. 2, July 1996. (emphasis added).

- ☐ Statement(s) that this is a filing by a small entity under 37 C.F.R. §§ 1.9 and 1.27 is(are) attached.

**WARNING:** "... Status as a small entity in one application or patent does not affect any other application or patent, including applications or patents which are directly or indirectly dependent upon the application or patent in which the status has been established. The refiling of an application under § 1.53 as a continuation, division, or continuation-in-part (including a continued prosecution application under § 1.53(d)), or the filing of a reissue application requires a new determination as to continued entitlement to small entity status for the continuing or reissue application. A nonprovisional application claiming benefit under 35 U.S.C. §§ 119(e), 120, 121 or 365(c) of a prior application, or a reissue application may rely on a statement filed in the prior application or in the patent if the nonprovisional application or the reissue application includes a reference to the statement in the prior application or in the patent or includes a copy of the statement in the prior application or in the patent if status as a small entity is still proper and desired. The payments of the small entity basic statutory filing fee will be treated as such a reference. . . ." 37 C.F.R. § 1.28(a)(2). (emphasis added).

**WARNING:** "Small entity status must not be established when the person or persons signing the . . . statement can unequivocally make the required self-certification." M.P.E.P., § 509.03, 6th ed., rev. 2, July 1996 (emphasis added).

(complete the following, if applicable)

- ☒ Status as a small entity was claimed in prior application

09 / 315,918, filed on 5/20/99, from which benefit is being claimed for this application under:

35 U.S.C. § ☐ 119(e),

☒ 120,

☐ 121,

☐ 365(c),

and which status as a small entity is still proper and desired.

- ☒ A copy of the statement in the prior application is included.

Filing Fee Calculation (50% of A, B, or C above)

\$ 417.00

**NOTE:** Any excess of the full fee paid will be refunded if a small entity statement and a refund request are filed within 2 months of the date of timely payment of a full fee. The two-month period is not extendable under § 1.136. 37 C.F.R. § 1.28(a).

**8. Fee Payment Being Made at This Time**

☐ Not Enclosed

☐ No filing fee is to be paid at this time.

*(This and the surcharge required by 37 C.F.R. § 1.16(e) can be paid subsequently.)*

☒ Enclosed

☒ Filing fee

\$ 417.00

*NOTE: Payment of a small entity basic filing fee will be treated as a reference to the statements in the prior application that status as a small entity is desired and proper. 37 C.F.R. § 1.28(a)(2).*

☐ Recording assignment

(\$40.00—37 C.F.R. § 1.21(h))

(See attached "COVER SHEET

FOR ASSIGNMENT ACCOMPANYING

NEW APPLICATION.")

\$ \_\_\_\_\_

☐ Petition fee for filing by other than all the  
inventors or person on behalf of the inventor  
where inventor refused to sign or cannot be  
reached

(\$130.00—37 C.F.R. §§ 1.47 and 1.17(i))

\$ \_\_\_\_\_

**Total fees enclosed**

\$ 417.00

**9. Method of Payment of Fees**

☒ Check in the amount of \$ 417.00

☐ Charge Account No. \_\_\_\_\_ in the amount of \$ \_\_\_\_\_  
A duplicate of this transmittal is attached.

*NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 C.F.R. § 1.22(b).*

**WARNING:** Unless an application under § 1.53(d) filed by facsimile includes an authorization to charge the basic filing fee to a deposit account, the applicant will be given a notification requiring payment of the appropriate filing fee (§ 1.53(d)(3)) and the late filing surcharge under § 1.16(e) to avoid abandonment of the § 1.53(d) application. 62 Fed. Reg. 53,131, 53,133 (Oct. 10, 1997).

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**10. Authorization to Charge Additional Fees**

**WARNING:** If no fees are to be paid on filing, the following items should not be completed.

**WARNING:** Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.

- ☒ The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. 16-0221.

☒ 37 C.F.R. § 1.16(a), (f), or (g) (filing fees)

☒ 37 C.F.R. § 1.16(b), (c), and (d) (presentation of extra claims)

**NOTE:** Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims canceled by amendment prior to the expiration of the time period set for response by the P.T.O. in any notice of fee deficiency (37 C.F.R. § 1.16(d)), it might be best not to authorize the P.T.O. to charge additional claim fees, except possibly when dealing with amendments after final action.

☒ 37 C.F.R. § 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

☒ 37 C.F.R. § 1.17(a)(1)-(5) (extension fees pursuant to § 1.136(a))

☒ 37 C.F.R. § 1.17 (application processing fees)

**WARNING:** "A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under § 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in § 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. § 1.136(a)(3).

☐ 37 C.F.R. § 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. § 1.311(b))

**NOTE:** Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the Notice of Allowance. 37 C.F.R. § 1.311(b).

**NOTE:** 37 C.F.R. § 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . . issue fee." From the wording of 37 C.F.R. § 1.28(b), (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.

**11. Instructions as to Overpayment**

**NOTE:** "Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amounts; amounts over twenty-five dollars may be returned by check or, if requested, by credit to a deposit account." 37 C.F.R. § 1.26(a).

☒ Credit Account No. 16-0221

☐ Refund

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Date: 3/8/00

Reg. No. 30,883

Tel. No. (781) 290-0060

Customer No.

Mark Pandiscio 3/8/00  
SIGNATURE OF PRACTITIONER

Mark J. Pandiscio  
(type or print name of practitioner)  
Pandiscio & Pandiscio  
470 Totten Pond Road

P.O. (Correspondence) Address  
Waltham, MA 02451-1914

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